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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **MATSUMOTO, Tsutomu et al.**

Group Art Unit: **2135**

Serial No.: **09/810,437**

Examiner: **Lin L.D. SON**

Filed: **March 19, 2001**

P.T.O. Confirmation No.: 7204

FOR: **CARD SETTLEMENT METHOD AND SYSTEM USING MOBILE INFORMATION TERMINAL**

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 27, 2006

Sir:

This paper is being filed in response to the Office Action dated **December 30, 2005**.

Applicants hereby request withdrawal of the finality of the Office Action, because it violates the guidelines for making a First Office Action Final as provided in MPEP §706.07(b).

Remarks begin on page 2 of this paper.

REMARKS

The Office Action mailed December 30, 2005 was improperly made final.

The applicant has reached this conclusion for two reasons as explained in MPEP §706.07(b).

First, MPEP §706.07(b) states,

“However, it would not be proper to make final a first Office Action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.” (Emphasis Added)

In this case an After Final Amendment was filed on September 12, 2005 in which claims 1, 2, 3, 5, 7 and 11 were amended. The Examiner responded with an Advisory Action mailed September 30, 2005 in which the amendments were not entered because they raise new issues that would require further consideration and/or search. On October 13, 2005 a Request for Continued Examination (RCE) was filed in which entry of the After Final Amendment filed September 12, 2005 was requested. The Examiner responded to the filing of this RCE with the Office Action mailed December 30, 2005 which was made final.

Since the Examiner refused to enter our After Final Amendment because it raised new issues requiring further consideration or search, he cannot make the First Office Action Final. Therefore, withdrawal of the finality of the Office Action mailed December 30, 2005 is respectfully requested.

Second, MPEP §706.07(b) states,

“A first Office Action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments
...”

In the Office Action mailed June 14, 2005 which is the last Office Action prior to the most recent Office Action mailed December 30, 2005 the grounds of rejection were as follows:

Claims 1, 3, 5-6, 11-14 and 17-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Maes et al. (U.S. 6,016,476), in view of Krlarksy (U.S. Publication No. 20010037308).

Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Maes et al., in view of Shkedy (U.S. 6,260,024).

In the most recent Office Action mailed December 30, 2005 the grounds of rejection are as follows:

Claims 1, 3, 4-6, 9/5, 10/5, 11-15, 16/5, 17/5 and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al. US Patent 6,016,476, in view of Krlarsky, US Publication No. 20010037308.

Claims 2, 7-8, 9/7, 10/7, 16/8, 12, 17/8 16/(8,12), and 17/(8,12) stand rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al. U.S. Patent 6,016,476 in view of Shkedy, U.S. Patent 6,260,024.

As indicated above different claims are being rejected over the same prior art. Therefore, the grounds for rejection has changed. The Examiner provides no explanation in the Office Action for

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this change in the grounds of rejection. Therefore, it must be assumed that the new grounds of rejection was necessitated by the amendments.

Therefore, again the Examiner cannot make this First Office Action Final. Therefore, withdrawal of the finality of the Office Action mailed December 30, 2005 is respectfully requested.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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